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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,561	03/04/2002	Basil Naji	BALDS2.024AUS	5549
20995	7590	10/06/2005	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			MARCANTONI, PAUL D	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/090,561

Applicant(s)

NAJI ET AL.

Examiner

Paul Marcantoni

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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Applicant's filing of an RCE on 6/27/05 is acknowledged.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 60191074 (abstract Matsushita), Brothers et al. '921, or Liskowitz et al. (WO 97/21640 which is PCT/US96/19936).

All of the above cited references teach fly ash in the range claimed by applicants of around 10 microns.

JP '074 teaches a particle size range of 90% smaller than 10 microns which thus meets the limitations of the claimed invention.

Brothers teach an amount of fly ash of 25 to 45 wt% which overlaps the instantly claimed composition. Further, the Blaine fineness of 10,585 square centimeters per gram overlaps the applicants' claimed particle size range.

Liskowitz (WO/PCT) also teach the applicants claimed particle size range for fly ash added to concrete. For all references above, overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art (see claims).

35 USC 112 Second Paragraph:

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

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Claim 1 is indefinite because applicants coating formulation and dewatering agent also require the coarse fraction which is particularly pointed out and distinctly claimed in claim 12. Applicants may overcome by inserting claim 12 into claim 1 as described below.

35 USC 112 First Paragraph-Enablement:

Claims 1-9 are rejected under the first paragraph of 35 USC 112 as the claimed invention is not commensurate in scope with applicants' enabling disclosure.

Applicants must include both a coarse fraction and fine fraction in their coating formulation. All the examples require the presence of both a fine fraction and a coarse fraction of fly ash. Applicants can easily overcome this enablement issue by inserting the limitations of claim 12 into claim 1 but they must additionally state that the second portion is the remainder of what is not used for the first portion. Language such as the following in claim 1 would place this application in condition for allowance (which of course would require the canceling of claim 12):

"wherein a first portion of the fly ash has a maximum particle size of about (please consider this change to about because that is the word used in the specification and about is more commonly used and understood than around) 10 microns and comprises 5 to 30 wt% of the formulation based on the total dry ingredients and the remainder is a second portion which is a coarser fraction fly ash having a a particle size diameter greater than 100 microns.

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It is the examiner's position that should applicants accept these changes in their next response, this application will be in condition for allowance.

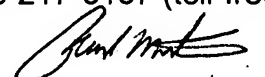
Claim 12:

Claim 12 is only objected to because it depends upon a rejected claim and would be allowable if combined with independent claim 1

Obviousness Type Double Patenting:

The ODP rejection has been withdrawn as a result of applicants' submission of a proper terminal disclaimer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Paul Marcantoni  
Primary Examiner  
Art Unit 1755